

Appl. No. 10/828,854
Amdt. dated March 18, 2005
Reply to Office action of February 15, 2005

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-17, 19-20, 22, and 24-25 are now in the application.

Claims 18, 21, 23, and 26 have been canceled. Claims 9, 13, 19, and 22 have been amended.

The revised amendment practice under 37 CFR 1.121, while otherwise not applicable to reissue applications, has been adopted herein with regard to the status identifier of each claim. The currently amended claims have been marked as such. The identifier "original" pertains to the filing of the reissue application. The reissue amendment practice of showing changes relative to the original patent by bracketing subject matter to be deleted and by underlining subject matter to be added has been otherwise retained. Instructions to cancel claims are being provided by a corresponding status identifier. The Office is instructed to cancel claims 18, 21, 23, and 26.

In light of the cancellation of claim 26, the restriction requirement appearing on page 2 of the Office action is now moot.

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With regard to the rejection appearing in the paragraph bridging pages 2 and 3 of the Office action, a supplemental reissue oath has been presented to the inventors for signature and it will be submitted as soon as it has been executed.

With regard to the objection to the specification, the first few lines of column 7 of the original patent have been amended. The flexo printing units are now correctly identified with the reference numerals 3 and 4.

Claim 9 of the original patent has been amended. The expression "final printing step" has been reworded so as to clearly refer back to its antecedent, namely, the step of "printing with the water-based ink" of claim 7.

Claim 22 has been amended by eliminating therefrom the term "dispersion." The rejections of the claim under 35 U.S.C. §§ 112 and 251 should now be moot.

The specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs, and of 35 U.S.C. § 251, subject to the filing of the supplemental reissue oath. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved.

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We now turn to the art rejection, in which claims 13-19 and 21-25 have been rejected as being obvious over a combination of DeMoore et al. (US 5,651,316, "DeMoore") and Sismanis et al. (US 6,042,888, "Sismanis") under 35 U.S.C. § 103. We respectfully traverse.

DeMoore discloses a highly variable printing system. There, each printing unit may be equipped either as a flexographic unit or as a lithographic unit. A hybrid system with flexographic printing and offset printing, for example, is illustrated in Fig. 3. Either printing processes may utilize water-based, hot-air dryable, or UV-curable inks. DeMoore also discloses that his system is able to "spot coat or overall coat" the print object. Col. 16, line 64. As such, one could even argue that DeMoore's rotary printing press could be used to perform the claimed invention.

This would not be a proper consideration, however, under the law of obviousness. Here, we must review the claims, develop the differences between the claimed invention and the prior art, and then weigh the question of obviousness against that background.

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First, a brief summary of the claimed invention as it is recited in the amended claim 13 may be beneficial: Here, we provide two distinct ink systems, with one of the ink systems being a radiation-curing, offset printing ink. First, the substrate is printed upon with the first ink system at a first printing area. Then the second ink system is offset onto a printing area that adjoins the first printing area. Finally, a closed layer of a transparent lacquer is coated onto the entire sheet, i.e., over the first printing area and over the second printing area.

Next, we turn to the disclosure of DeMoore in order to determine the express and inherent teachings in the reference that may point towards the above-summarized method: There, the primary benefit to be had is the ability of the printing press to print with different print systems and to use one of the print systems as a foundation and to overprint with the other print system. This is also the reason why DeMoore places his high-velocity hot air dryer/extractor units immediately downstream of each of the printing units. If the respective inking/coating apparatus is set to apply a UV-curable ink or coating, then DeMoore also provides "ultra-violet dryers/extractors . . . adjacent to the high velocity hot air dryer/extractor units." Col. 16, lines 40-44. In either case,

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the reference deals with underlying base printing and following overprinting.

The purpose of the dryers is explained as follows:

Sharpness and print quality are substantially improved since the flexographic ink or coating material is dried before it is overprinted on the next printing unit.

DeMoore, col. 15, lines 31-33 (emphasis added).

Moreover, this arrangement permits the first printing unit 22 to be used as a coater in which a flexographic, aqueous or UV-curable coating material is applied to the lowest grade substrate such as recycled paper, cardboard, plastic and the like . . . provide a smoother, more durable printing surface which can be overprinted on the next printing unit . . . improves overprinted dot definition and provides better ink lay-down.

DeMoore, col. 15, lines 42-52 (emphasis added).

That is, the primary reference is concerned with overprinting issues and substrate printing which prepares the sheet or a base image for overprinting. There is no disclosure in DeMoore that would point towards the step of printing with two ink systems in mutually adjoining zones.

This was apparently also recognized by the Examiner ("do not specifically teach that the first printing area 'adjoins' the second printing area," Office action, p. 4). While we agree, we must emphasize that DeMoore not only does not "specifically teach" the element, but in fact teaches against it. There

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exists a fundamental difference between two-system overprint, on the one hand, and "adjoining" print, on the other hand.

The modification of the primary teaching of DeMoore with Sismanis - as proffered by the Examiner - is not proper. Firstly, the combination of the teachings, and the resulting modification, is not suggested in either reference, nor is it suggested in the art as a whole. Secondly, the primary reference teaches away from the modification, because it is centrally and exclusively concerned with overprint considerations). Thirdly, a justification for the combination and modification can only be arrived at with hindsight.

It is well settled that almost all claimed inventions are but novel combinations of old features. However, when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added).

"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination".

In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined only if

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there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). As pointed out above, there is no "clear and particular" teaching or suggestion in either reference to modify the "overprint" teachings with the "adjoining print" teachings of the other reference.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps The references themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d

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1885, 1888 (Fed. Cir. 1991). Here, no such teaching is present in either DeMoore or Sismanis.

In summary, none of the references, whether taken alone or in any combination, either show or suggest the features of claim 13. Claim 13 and its dependent claims are therefore patentable over the art.

The rejection of claim 20 as being obvious over the above combination of DeMoore and Sismanis, and further in view of Kistler et al. (US 5,791,251) under 35 U.S.C. § 103(a) has been noted as well. The reference Kistler et al. has been cited with regard to the element of the specially mixed ink. While the teaching is acknowledged, it is noted that Kistler et al. do not go beyond the primary combination with regard to the method of claim 13. That is, the teaching of Kistler et al. does not make up for the shortcomings of the primary/secondary combination with regard to claim 13. Claim 20 is therefore patentable over the art of record for the same reasons given above concerning the patentability of claim 13.

The allowance, or indicated allowability, of claims 1-12 is appreciatively noted.

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In view of the foregoing, reconsideration and allowance of claims 1-17, 19-20, 22, and 24-25 are solicited.

Respectfully submitted,



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